



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,963	07/29/2003	Richard W. Nykamp	76764.(new)	6180

24335 7590 12/07/2005

WARNER NORCROSS & JUDD LLP  
900 FIFTH THIRD CENTER  
111 LYON STREET, N.W.  
GRAND RAPIDS, MI 49503-2487

EXAMINER
----------

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,963

Applicant(s)

NYKAMP ET AL.

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,11,12 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,11,12 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Repeated Rejections***

1. The 35 U.S.C. 102 rejection of claims 1, 3, 11 and 12 as anticipated by Flesher is repeated for the reasons previously set forth in the Office Action mailed 5/18/05, Page 2, Paragraph #2.
2. The 35 U.S.C. 103 rejection of claims 17-19 over Malino in view of Flesher is repeated for the reasons previously set forth in the Office Action mailed 5/18/05, Pages 3-4, Paragraph #4.

### ***Response to Arguments***

3. Applicant's arguments filed 9/22/05 have been fully considered but they are not persuasive. Applicants argue that "with regard to the hypothetical combination of Malino and Flesher, it is respectfully submitted that the references are not properly combinable...the improper combination does not teach an article of office furniture having multiple components each covered by a decorative cover having dimensions substantially the same as the respective components".

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Art Unit: 1772

In this case, Malino clearly teaches a metal office furniture piece including a plurality of components each having dimensions as shown in Figure 6. It is to be pointed out that element 20 in Figure 6 of Malino teaches a magnetic cover (calendar) attached to the piece of metal office furniture such as a filing cabinet. Further, the magnetic calendar in Malino comprises a magnetic sheet and decorative material (see Figs. 7 and 8; also see col. 4, lines 20-28). Flesher was merely cited for suggesting that it is old and well-known in the art to have a magnetic decorative cover of different shapes (see Figs. 2A-2F, elements 100) and having dimensions substantially the same as the component (in this case the front of a car) to which it is covering (see Figure 1, elements 100) and to have each of the covers comprise a flexible, magnetic sheet and a vinyl decorative material (see col. 4, lines 50-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the size of the decorative magnetic cover in Malino to have dimensions substantially the same as the dimensions of the component to which the decorative magnetic cover is being attached as suggested by Flesher and to have modified the magnetic decorative cover in Malino to comprise a flexible, magnetic sheet and vinyl decorative material as suggested by Flesher in order to provide a decorative appearance to a metal component. One skilled in the art would clearly be able to alter the size of the magnetic decorative cover in Malino in order to have dimensions substantially the same as the dimensions of the component to which it is attached, if so desired. Thus, the claims fail to patentably define over the prior art as applied above.

Applicants then argue that "Flesher does not disclose the recitations of independent claim 11. First, Flesher has nothing to do with "altering the appearance of a metal office furniture article". Second, and as noted above, the magnetic covers in Flesher do not each have

“dimensions substantially the same as the dimensions of the corresponding component”. Third, the pieces of the Flesher cover do not “substantially cover the entire component” to which it is adhered.”

First, in response to applicant's arguments, the recitation “altering the appearance of a metal office furniture article” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Second, Flesher clearly teaches magnetic covers each having dimensions substantially the same as the dimensions of the corresponding component (see Figs. 2A-2F and Figure 1, elements 100). Third, Flesher clearly teaches each magnetic cover substantially covering the entire component to which it is adhered (Fig. 1, elements 100).

Applicants further argue that “Flesher also does not disclose the recitations of independent claim 1. First, Flesher does not disclose “a decorative cover for a metal office furniture component having a physical feature”. Second, the Flesher cover does not include an aperture positioned to be aligned with a physical feature on a metal office furniture component”.

First, in response to applicant's arguments, the recitation “a decorative cover for a metal office furniture component having a physical feature” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a

Art Unit: 1772

structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Second, the cover of Flesher clearly defines an aperture (Fig. 2E, element 98) positioned to be aligned with a physical feature when the cover is mounted on a component (see col. 2, lines 6-10).

### ***Response to Amendment***

4. The declaration filed under 37 CFR 1.132 filed 9/22/05 is insufficient to overcome the rejections of claims 1, 3, 11, 12 and 17-19 based upon the Flesher and Malino references as set forth in the last Office action because: facts presented are not germane to the rejection at issue and showing is not commensurate in scope with the claims. It refers only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 1772

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

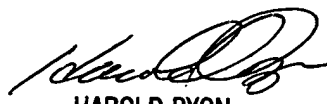
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine A. Simone  
Examiner  
Art Unit 1772  
December 4, 2005



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/5/05